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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,506	11/09/2001	Michael D. Hooven	HOOV 114	6492
7590	05/20/2008			
Cook, Alex, McFarron, Manzo, Cummings & Mehler, Ltd. Suite 2850 200 West Adams Street Chicago, IL 60606			EXAMINER CHEN, VICTORIA W	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 05/20/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/038,506	HOOVEN, MICHAEL D.	
	<b>Examiner</b>	<b>Art Unit</b>	
	VICTORIA W. CHEN	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 November 2007.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/20/08</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yates et al. (US 5403312).**

Regarding claim 1, Yates discloses a first [12] and second [unlabelled element in Fig. 2 containing elements 66 and 61] handle members, first [734] and second [732] jaws movable between a first [Fig. 17] and second [18] position, wherein the second position is a clamped position with the jaws substantially parallel, a clamping surface on each jaw [Fig. 18, the entire surface portion of each jaw that is facing the other jaw] having a width, a first elongated electrode [752] on the first jaw having a tissue contacting portion [Fig. 18, surface of 752 facing jaw 732] with a width, the width of the clamping surface exclusive of the width of the tissue contacting portion being wider than the width of the tissue contacting portion [Fig. 18], a second elongated electrode [751] on the second jaw having a tissue contacting portion [Fig. 18, surface of 751 facing jaw 734] with a width, the width of the clamping surface exclusive of the width of the tissue contacting portion being wider than the width of the tissue contacting portion [Fig. 18], the first and second electrodes being in face to face relationship, adapted to be of opposite polarity [Fig. 18] and connected to an RF energy source [60].

Regarding claim 3, Yates discloses first [734] and second [732] jaws movable between a open [Fig. 17] and closed [18] position, wherein the second position the jaws are substantially parallel, and at least a portion of the jaws [Fig. 18, side walls of both jaws labeled as 723 on jaw 734 and unlabeled on jaw 732, or alternatively the side walls of the knife channel labeled 726 and 742], each jaw including an elongated electrode [751, 752], a clamping surface on each jaw [Fig. 18, the entire surface portion of each jaw that is facing the other jaw] having a width and non-conductive portions [755a, 755b], each electrode having a tissue contacting portion having a width, the width of the clamping surface exclusive of the width of the tissue contacting portion being wider than the width of the tissue contacting portion [Fig. 18], the first and second electrodes being in face to face relationship, adapted to be of opposite polarity [Fig. 18] and connected to an energy source [60].

Regarding claims 2 and 4, Yates discloses the space between the parallel jaws to be approximately between 1 to 15mm when in the clamped position [col. 7, ll. 27-29].

Regarding claim 5, Yates discloses each clamping surface of the jaws comprises insulative material [755a, 755b].

Regarding claims 6 and 7, Yates discloses each electrode is generally centrally located relative to the width of the clamping surface [Fig. 18].

#### ***Response to Arguments***

Applicant's arguments filed 11/19/07 have been fully considered but they are not persuasive. Applicant argued that Yates fails to teach a face to face relationship between first and second electrodes. However, the examiner interprets the phrase "face to face" as "being in the presence of another; facing" ["face to face." *The American Heritage® Dictionary of the English*

*Language*, 4th ed. Boston: Houghton Mifflin, 2000. [www.bartleby.com/61/](http://www.bartleby.com/61/). Accessed: May 15, 2008.]. In light of this definition, the electrodes seen in Fig. 17 of Yates can be interpreted as being in the presence of the other and facing towards each other, albeit in an off-set position. The fact that Yates states the two electrodes are electrically isolated from each other has no bearing on whether they are face to face. Regarding Applicant's argument that Yates does not suggest the jaws are parallel, the claim language does not necessitate that the portions of the jaws that are parallel are on two separate jaws. Claim 1 recites "at least portions of the jaws being parallel through a range of tissue clamping spacing" [claim 1, ll. 10-11]. Examiner interprets the portions of each jaw as being two points on the same jaw, which are therefore parallel to each other through a range of tissue clamping spacing since they are at a set distance from each other at all times. The rejections are therefore upheld.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victoria W Chen/  
Examiner, Art Unit 3739

/Michael Peffley/  
Primary Examiner, Art Unit 3739